

**ATER WYNNE** LLP  
ATTORNEYS AT LAW

**RECEIVED**  
**CENTRAL FAX CENTER**

**SEP 07 2007**

Suite 1800  
222 S.W. Columbia  
Portland, OR 97201-6618  
503-226-1191  
Fax 503-226-0079  
www.aterwynne.com

**FACSIMILE TRANSMITTAL**

<b>Date</b>	September 7, 2007
<b>From</b>	Nicholas Weintraub

<b>To</b>	<b>Company</b>	<b>Fax</b>	<b>Phone</b>
Mail Stop AF	United States Patent and Trademark Office	(571) 273-8300	(703) 308-9102

<b>Document</b>	Pre-Appeal Brief		
<b>Pages</b>	7 (including cover)	AN ORIGINAL OF THIS FAX WILL ____ WILL NOT <u>X</u> FOLLOW.	

<b>Message</b>
Please find following a Pre-Appeal Brief for patent application no. 10/715,871, inventor Epley, John M.

**NOTICE:** This facsimile contains confidential information that is being transmitted to and is intended only for the use of the recipient named below. Reading, disclosure, discussion, dissemination, distribution or copying of this information by anyone other than the named recipient or his or her employees or agents is strictly prohibited. If you have received this facsimile in error, please immediately destroy it and notify us by telephone, 503-226-1191.

SEP 07 2007

Attorney Docket No. 103419-0003

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Epley, John M.

Serial No. 10/715,871

Examiner: Hoekstra, Jeffrey Gerben

Confirmation No. 5600

Filed: November 17, 2003

Group Art Unit: 3736

For: HEAD-STABILIZED MEDICAL APPARATUS, SYSTEM AND METHODOLOGY

Date: September 7, 2007

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant respectfully requests review of the final rejection in the Office Action mailed on July 31, 2007 in the above-identified application. The assertions underlying each claim rejection in the office action are based upon clear legal and factual errors, and the cited references fail to teach or suggest all the claim limitations of any claim as detailed herein. As a result, the office action fails to establish a *prima facie* case of unpatentability under 35 §103(a) regarding any of the claims rejected in the final office action. A Notice of Appeal is filed herewith.

**Clear Factual Errors Regarding Rejections Under 35 §102(b)**

Claims 1-8 and 20-23 stand rejected under 35 §103(a) as being unpatentable over U.S. Pat. 6,159,171 to Densert et al. (hereinafter Densert) in view of Galiana et al. (hereinafter Galiana).

- Independent claim 1 recites in part: "Apparatus . . . comprising . . . head-wearable frame structure . . . configured to control visual input by at least partially obstructing the subject's normal visual range",
- Independent claim 7 recites in part: "Apparatus . . . comprising . . . frame structure wearably securable to a subject's head . . . configured to control visual input by at least partially obstructing the subject's normal visual range", and
- Independent claim 20 recites: "System . . . comprising . . . headgear worn by a subject, including frame structure . . . configured to control visual input by at least partially obstructing the subject's normal visual range".

"A claim is anticipated only if *each and every* element as set forth in the claim is found, either *expressly or inherently* described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of CA*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131 (emphasis provided).

In the Final Office Action, the Examiner expressly concedes that Densert fails to explicitly disclose or show a head-wearable frame structure "configured to control a visual input by at least partially obstructing the subject's normal visual range", (Page 3, section 8). The Examiner then asserts that "Galiana teaches and shows (*as best seen* in Figures 3 and 4) a vestibular measuring/modifying device . . . configured to control a visual input via a display (12) by at least partially obstructing the subject's normal visual range" (Office Action, page 3, section 8)(emphasis added).

The Examiner modifies this position in the Advisory Action mailed August 30, 2007, asserting instead that "[t]he visual display incorporated on the frame structure is shown in *Figure 1* (not Figures 3 or 4) and described (abstract, Column 1 lines 10-16, and column 2 lines 39-55)(emphasis added). However, the Examiner's assertions in both the Final Office Action and the Advisory Action contain clear factual and legal errors, and fail to establish a *prima facie* case as required to properly reject independent claims 1, 7, and 20 under 35 U.S.C. §103(a).

#### **Regarding Claims 1, 7 and 20**

The Examiner asserts in the Advisory Action that applicant's claim recites an intended use and implies that the claim does not recite a structural difference from the asserted references. However, the recited claim limitation is not merely an "intended use". Rather, Applicant's recited limitations limit the claim to a particular structural feature that is material to patentability, a "head-wearable frame structure . . . *at least partially obstructing the subject's normal visual range*", (MPEP 2111.04)(emphasis added). Therefore, to meet the limitations, the combined references must teach or suggest a head-wearable frame structure which *itself* at least partially obstructs the subject's normal visual range. The visual range-obstructing feature cannot be separate from the head-wearable frame structure, nor provided by a separate structure or device, and yet disclose applicant's claims. The combined references, and Galiana in particular, fail to so teach or suggest, and the assertion constitutes both factual and legal error.

As pointed out by applicant in the After Final response of August 17, 2007, Galiana's Figures 3 and 4 do not depict a display (12) *at all*, contrary to the Examiner's assertion that Figures 3 and 4 "best show[]" the display, variously identified by Galiana as Target Display 12 (Figures 1-2) and Head's Up Display 12 (column 4, lines 22-23). Further and more clearly undercutting the Examiner's arguments and supporting applicant, Galiana's Figure 1, newly referenced and relied upon by the Examiner in the Advisory Action, depicts the "Head Perturber" and the "Target Display" *separately* and distinctly from one another. Figures 3 and 4 and the Galiana description further establish the separation between the head perturber and the target display. For example, Galiana describes and shows a head perturber as the

entire structure(s) depicted as feature 30 of Figure 3 and described at column 7, lines 59-60 ("inertial head perturber"), and as feature 49 of Figure 4 described column 8, lines 20-21 ("Lorentz force perturber"). Neither description or figure includes or suggests the presence of a display, and applicant respectfully submits that the Examiner's interpretation improperly involves hindsight based on applicant's claims.

Figure 1 clearly depicts and identifies a head perturber 10 *separately* from a target display 12, and nowhere suggests that the head perturber *is configured to include* the target display. Although Galiana may disclose an apparatus which includes a head perturber, and also *separately* includes a target display, Galiana fails to disclose the required structural limitation of a "head-wearable frame structure . . . at least partially obstructing the subject's normal visual range". Therefore, not only is there no mention in Galiana that a display at least partially obstructs the subject's normal visual range, Galiana also clearly depicts the target display separately from the head perturber in Figure 1, and depicts two head perturbers lacking displays in Figures 3 and 4, teaching away from the Examiner's assertions.

Inasmuch as Galiana, relied upon by the Examiner to supply the limitations missing from Densert, (a) depicts two separate head perturbers (asserted by Examiner to disclose a head-wearable frame structure) in Figures 3 and 4, neither of which depicts a display 12, (b) *separately* depicts in Figure 1 a head perturber 10 and a display 12, and (c) fails throughout the description to teach, suggest, or describe a head-wearable frame structure configured to structurally include the visual range obstructing limitations of applicants claims, applicant respectfully submits that the combined references fail to provide a *prima facie* case sufficient for rejection as required under 35 U.S.C. § 103(a).

The Examiner expressly invokes a theory of inherency for the first time in the most recent Advisory Action; "Not only does the device as taught by Galiana inherently 'at least partially obstruct[] the subject's normal visual range' it is also capable of the intended use", (Advisory Action, page 3, paragraph 2). This assertion constitutes both factual and legal error. As earlier discussed, applicant's recited limitations limit the claim to a particular visual range-obstructing structure, not merely an intended use. Further, the Examiner errantly asserts the inherency theory.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); MPEP § 2112(IV)(emphasis in original). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); MPEP § 2112(IV), (emphasis in original).

Because Galiana depicts head perturbers (Figs. 3 and 4) that do not include a display asserted by the Examiner to at least partially obstruct the subject's normal visual range, and instead clearly depicts the

target display and the head perturber separately in Figure 1, the asserted references contradict rather than support the Examiner's contention that the head perturber(s) inherently includes the asserted display. If the Examiner were correct, Galiana would have been required to disclose the necessary structural relationship in the patent. However, as shown, Galiana consistently depicts separation rather than conjunction, and head perturbers lacking rather than including displays "at least partially obstructing the subject's normal visual range".

Additionally, even the separate display of Galiana does not necessarily partially obscure the user's normal range of vision, nor does any other structure in the combined references meet applicant's visual range-obstructing limitation. Rather, Galiana teaches away from the Examiner's assertions. For example, applicant notes that Galiana repeatedly refers to the display as a "Heads-Up Display 12" (column 4, lines 22-23, 47-48, 66-67, etc.). Heads-up displays have been known to those of ordinary skill in the art since well before applicant's filing date. For example, U.S. patent 6,091,376 entitled "Mobile Telephone Equipment with Head-Up Display" and issued July 18, 2000 (well before applicant's November 17, 2003 filing date), describes:

FIGS. 2(a) and 2(b) show, by way of example, respective images displayed by the *head-up display*. [ ] The touch panel 6 (see FIG. 3) is formed on the front windshield 5 in a pattern corresponding to the displayed telephone push buttons. [ ] The touch panel 6 comprises transparent electrodes such as of ITO (indium oxide) or Nesa electrodes such as of tin oxide *which do not obstruct the vision of the driver*. (Column 3, lines 14-15, 19-20, and 57-60)(Emphasis added)

Likewise, patent application 10/109490 (publication number 20020180696) published December 5, 2002, describes,

a "*heads up*" *display* concept enabled in applications such as vehicle windows, home windows, business windows, interior store windows at a mall, and the like. [ ] [T]he window display device enables an "on window" viewing and entering of information, wherein the information is displayed and edited in a semi-transparent overlay manner on a physical window or transparent media. This way the display and entry of information *does not obstruct the visibility through the window*. (Page 6, paragraph 69)(Emphasis added)

A recent, publicly accessible Wikipedia entry dated February 13, 2007 reflects the same knowledge that has been present in the art (as demonstrated by the above-cited patents): A "head-up display", also known as a "heads-up display" or "HUD", is any transparent display that presents data *without obstructing the user's view*." ([http://en.wikipedia.org/w/index.php?title=Head-up\\_display&diff=154310341&oldid=107737462](http://en.wikipedia.org/w/index.php?title=Head-up_display&diff=154310341&oldid=107737462); accessed September 4, 2007)(Emphasis added).

Thus, Galiana's Heads-Up Display 12 neither inherently nor ordinarily at least partially obstructs a subject's normal visual range. Heads-up displays are used in critical navigational applications precisely because they provide visual information while not distracting a subject's attention or obstructing their

normal visual range. Because the prior art indicates that a heads-up display, such that of Galiana, does not *necessarily* at least partially obstruct the subject's normal visual range, the display of Galiana does not *inherently* teach or suggest applicant's claim limitation also missing from Densert. Rather, applicant submits that the Examiner's rejection is based upon improper hindsight, borrowing from applicant's disclosure to provide a teaching which does not exist in either Galiana or Densert, and contrary to knowledge within the level of ordinary skill at the time the claimed invention was made. Therefore, the Examiner's assertions constitute legal and factual error.

For at least these reasons, as well as all others asserted in applicant's response to the Final Office Action submitted August 17, 2007, applicant submits that the Examiner fails to establish a *prima facie* case necessary for a proper rejection of applicant's claim 1 under 35 U.S.C. § 103(a). Inasmuch as independent claims 7 and 20 likewise recite claim limitations similarly distinct from the asserted references, applicant submits that the Examiner likewise fails to establish a *prima facie* case sufficient for a proper 35 U.S.C. § 103(a) rejection of these claims for at least the same reasons as apply to claim 1.

Therefore, applicant respectfully requests withdrawal of the finality of the rejection of applicant's claims 1, 7, and 20, and allowance of these claims without undue delay.

**Regarding Dependent Claims 2-6, 8 and 21-23**

Inasmuch as claims 2-6, 8 and 21-23 depend from and include the limitations of independent claims 1, 7 and 20, respectively, applicant submits that the Final Office Action also fails to establish a *prima facie* case under 35 U.S.C. 102(b) with regard to claims 2-6, 8 and 21-23. Therefore, applicant respectfully requests withdrawal of the finality of the rejection of claims 2-6, 8 and 21-23, and allowance of these claims without undue delay.

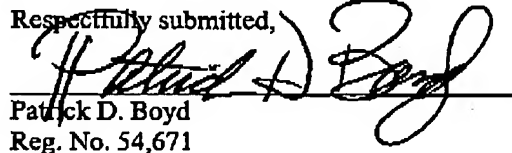
**Conclusion**

In light of the arguments set forth herein, applicant respectfully submits that all rejections asserted in the Final Office Action are shown herein to be improperly based upon clear factual and legal errors, and that a *prima facie* case is not established to support the rejections. Applicant therefore respectfully requests that all claims be allowed without undue delay.

I hereby certify that this correspondence is being transmitted to the U.S. Patent and Trademark Office via facsimile number 571-273-8300 on the following date: September 7, 2007

  
NAME

Respectfully submitted,

  
Patrick D. Boyd  
Reg. No. 54,671

Customer No. 35940